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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/038,584

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Junko Takahashi

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7590

09/10/2002

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EXAMINER

SHAHER, RICKY D

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 09/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AR2

**Office Action Summary**

Application No.

10/038,584

Applicant(s)

TAKAHASHI ET AL

Examiner

R.D. SHAFFER

Group Art Unit

2872

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 month MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- ☒ Responsive to communication(s) filed on 6/28/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- ☒ Claim(s) 1-51 is/are pending in the application.
- Of the above claim(s) 1-10, 22-32 AND 35-37 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 11-26, 33, 34 AND 38-51 are subject to restriction or election requirement

**Application Papers**

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

**Attachment(s)**

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_ ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other: \_\_\_\_\_

**Office Action Summary**

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1. Applicant's election of species "h", depicted by Fig. 7, in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 1-10, 27-32 and 35-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species. Election was made without traverse in Paper No. 5.

3. Applicant asserts that claims 11-26, 33, 34 and 38-51 read on the elected species "h", depicted by Fig. 7. The examiner agrees that claims 11-14, 18, 20, 21, 33 and 34 read on the elected species. However, the examiner disagrees that claims 15-17, 19, 22-26 and 38-51 read on the elected species for the reasons stated below. wrong

The examiner is of the opinion that claims 15-17 and 19 are drawn to one of other species, such as figures 9(a), 10, 15 or 16, due to the fact that the first and third surfaces are curved (includes power) which is not the case with elected species "h", which would appear to illustrate that the first and third surfaces are flat (excludes power).

The examiner is of the opinion that claims 22-26 are drawn to one of other species, such as figures 8(a) or 8(b), due to the fact that the prism is movable which is not the case with elected species "h", which would appear to define that the prism is fixed (see page 31, lines 14-22 of the specification).

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The examiner is of the opinion that claims 38-43 are drawn to one of other species, such as figures 10-14, due to the fact that the prism includes an aberration correcting means outside of the second surface of the prism which is not the case with elected species "h", which would appear to exclude any aberration correcting means outside of the second surface of the prism.

The examiner is of the opinion that claims 44-51 are drawn to one of other species, such as figures 15 or 16, due to the fact that the apparatus includes a second optical element that cancels power produced by the refracting and internally reflecting surface and is disposed on an outside world side of the outside world-side internally reflecting surface which is not the case with elected species "h".

Accordingly, the examiner is of the opinion that claims 15-17, 19, 22-26 and 38-51 do not read on the elected species "h" and that only claims 11-14, 18, 20, 21, 33 and 34 should be examined on the merits as being drawn to the elected species.

However, in order to avoid any possible misinterpretation of what claims should and should not be examined on the merits, the examiner further requires the following election of species in order to avoid any confusion.

In respond to this further election of species, applicant is required to provide a detail explanation as to how such claim(s) read on the elected species if any of such claim(s) are different than what the examiner has already determined above to read on the elected species "h", that being claims 11-14, 18, 20, 21, 33 and 34. Failure to provide any such detail explanation will be construed by the examiner that applicant is in full agreement with the examiner that only claims

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11-14, 18, 20, 21, 33 and 34 read on the elected species "h" and has acquiesced the examination of claims 15-17, 19, 22-26 and 38-51.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

- 1). The first and third surfaces being curved; and
- 2). The first and third surfaces being planar.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species consistent with the elected species "h", depicted by Fig. 7, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, at least claim 12 is generic.

In addition, this application further contains claims directed to the following patentably distinct species of the claimed invention:

3. The prism is fixed; and
4. The prism is movable.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species consistent with the elected species "h", depicted by Fig. 7, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, at least claim 12 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon,

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including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R.D. Shafer whose telephone number is (703) 308-4813.

RDS

September 8, 2002

*Ricky D. Shafer*  
RICKY D. SHAFER  
PATENT EXAMINER  
ART UNIT 2872